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In re Application of:

CRASTER, Bernadette, et al.
U.S. Application No.: 10/542,654
PCT No.: PCT/GB2004/000575
Int'l Filing Date: 20 February 2004
Priority Date: 20 February 2003
Atty Docket No.: 57.0513 US PCT
For: SYSTEM AND METHOD FOR
MAINTAINING ZONAL ISOLATION
IN A WELLBORE

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed 05 May 2006. Applicants have submitted the required \$200 petition fee.

BACKGROUND

On 20 February 2004, applicants filed international application PCT/GB2004/000575. The international application claimed a priority date of 20 February 2003, and it designated the United States. On 02 September 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 20 August 2005.

On 19 July 2005, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 02 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497.

On 05 May 2006, applicants filed a response to the Notification Of Missing Requirements which included a declaration executed by seven of the eight inventors and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the declaration without the signature of the remaining inventor, Roger CARD, whom applicants assert cannot be located after diligent effort.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have submitted the required petition fee, and the petition expressly states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed what appears to be a partial declaration executed by seven of the eight named inventors. The declaration indicates that it is a nine-page document; however, only eight pages have been submitted, and these eight pages do not identify Roger Card as an inventor and do not include an unsigned signature block for Dr. CARD.¹ The declaration as filed is therefore unacceptable with respect to all the inventors, as it fails to identify all the inventors herein. Item (3) is therefore not satisfied.

Regarding item (4), the petition appears to assert that the non-signing inventor cannot be reached or located after diligent effort. Section 409.03(d) of the MPEP states the following concerning such cases:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See

¹ The missing page ("Page 3 of 9") might have been the unsigned signature page for the non-signing inventor, but this cannot be confirmed without applicants' submission of a copy of the complete declaration executed by the cooperating inventors.

MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants have not provided the required statement from a person with firsthand knowledge of the attempts made to locate the inventor (a document that lists some such efforts has been provided, but it is not accompanied by a confirming statement from the person(s) who actually undertook these actions, as required). Applicants must supplement the present submission with the required firsthand statement(s) confirming the actions taken to locate the non-signing inventor. As discussed in the MPEP section quoted above, such statements should be accompanied by available documentary support (i.e., a copy of the results of the internet searches conducted, copies of the letters and facsimile directed to the inventor, a copy of the returned envelopes confirming that the inventor's address is no longer current, etc.). Until such materials are provided, item (4) is not considered satisfied.²

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (3) and (4) of a grantable petition, as discussed above, that is: (1) a complete and acceptable declaration in compliance with 37 CFR 1.497 that is executed by each of the co-operating inventors and includes an unsigned signature block for the non-signing inventor, and (2) the firsthand and documentary evidence required to demonstrate that a diligent effort has been made to locate a current address for the non-signing inventor and obtain his signature at such address.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

² It is noted that the petition also includes a "Confidential Information Agreement" relating to the non-signing inventor's obligations towards the assignee with respect to the invention. However, any such obligations are irrelevant with respect to the inquiry here, that is, whether the inventor has refused to execute the application or cannot be located after diligent effort.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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